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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,235	10/19/2000	Katsuya Murakoshi	198554US2	5024

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EXAMINER

STEPHANY, TIMOTHY J

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,235

Applicant(s)

MURAKOSHI, KATSUYA

Examiner

Timothy J. Stephany

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4 / 12-21-00.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Specification

The disclosure is objected to because of the following informalities:

On page 5, lines 5-6: grammatical error, the phrase "and one transfer sheet trays" should read "and one of the transfer sheet trays".

On page 5, line 18: grammatical error, the phrase "in one of print colors" should read "in one of the print colors".

On page 10, line 23: confused rendering, the phrase "1 channel" should read "1st channel" or "channel one" and the phrase "2 channel" should read "2nd channel" or "channel two".

On page 12, line 2: typographical error, "Fig. 201" should read "Fig. 1".

On page 17, line 9: missing comma, the phrase "facsimile image data based on" should read "facsimile image data, based on".

Appropriate correction is required.

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Drawings

The drawings are objected to because reference characters **S200-S204** in the spec are shown as **200-204**, **S400-S406** in the spec are shown as **400-406**, and **S600-S615** in the spec are shown as **600-615**. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: **616**. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Also, consistent with the above objection the reference character inserted into the specification and drawing should be **S616**. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-5, 10-14 and 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Tadokoro ('707).

Regarding **claim 1, 10 and 19**, Tadokoro discloses a communications apparatus (and thus a means and method) wherein the method of communication is related to the color that is printed by the printer (col. 6, lines 38-42) and that the originator identification information is received in a relationship with color (Figure 9) in the memory (col. 8, lines 27-30) through a communication means that is receiving and sending and with a printer that prints one of a plurality of colors (abstract). Tadokoro also includes paper size sheet selection (col. 8, lines 50-54 and **F24** in Figure 11).

Regarding **claims 2, 11, and 20**, Tadokoro discloses a communications apparatus (and thus a means and method) stated in the claim 1 rejection above, and adds that there is one color that is selected from a plurality of colors according to the first data table above (col. 6, lines 38-42) that is a relationship between the print colors and the method of communication.

Regarding **claims 3, 12, and 21**, Tadokoro discloses a communications apparatus (and thus a means and method) stated in the claim 1 rejection above, and has already been shown to include identification information in relation to color (col. 8, lines 31-35 and Figure 9).

Regarding **claims 4, 13 and 22**, Tadokoro discloses a communications apparatus (and thus a means and method) stated in the claim 1 rejection above, and adds the use of either G3 or G4 protocols for facsimile transmission (col. 1, lines 44-45).

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Regarding **5, 14, and 23**, Tadokoro identifies the user's (receiving) and partner's (sending) terminals (**F41 and F42** in Figure 16), the means of accomplishing the method or apparatus is inherent to it. If a small number of potential embodiments come to them mind of one skilled in the art such that that person would have at once envisaged that which is claimed, such as identification information arising from a transmitting terminal, a receiving terminal or a remote terminal, then the reference anticipates the claim, and thus is rejected under the same justification as claim 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-9, 15-18, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tadokoro ('707).

Regarding claims **6, 15, and 24**, Tadokoro has already been shown to disclose a communications apparatus (and thus a means and method) with a table representing a relationship between a plurality of print colors and communication type, and selection of one of these colors, in which sheet media selection can also be performed in the rejection to claim 1. The incorporation of these into a separate data table in any of

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various configurations would have been obvious to one skilled in the art and thus claims 6, 15, and 24 are rejected under the same justification as claim 1.

Regarding claims **7, 16, and 25**, Tadokoro discloses the apparatus (and thus a means and method) in the rejection of claims 6, 15 and 24. Tadokoro includes the selection of one of a plurality of colors and a type of sheet based on the method of communication from the rejections to claims 1 and 2, and thus claims 7, 16, and 25 are rejected under the same justification as claims 1 and 2.

Regarding claim **8, 17, and 26**, Tadokoro has already been shown to disclose a communications apparatus (and thus a means and method) with a table representing a relationship between a plurality of print colors and communication type, and selection of one of these colors, in which sheet media selection can also be performed in the rejection to claim 6. The incorporation of these into a separate data table in any of various configurations would have been obvious to one skilled in the art and thus claims 8, 17, and 26 are rejected under the same justification as claim 6.

Regarding claim **9, 18, and 27**, Tadokoro discloses the apparatus (and thus a means and method) in the rejection of claims 6, 15 and 24. Tadokoro includes the selection of one of a plurality of colors and a type of sheet based on the method of communication from the rejections to claims 1 and 2, and thus claims 9, 18, and 27 are rejected under the same justification as claims 1, 2 and 6.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai ('771) in view of Mitsuo (JP-A 04-270548), further in view of Ng ('661).

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Regarding **claim 1-3, 10-12 and 19-21**, Sakai discloses a facsimile apparatus (and thus a means and method) wherein the originator identification information is received, a memory for pre-storing (table) identification information in correspondence with printing colors (col. 2, lines 20-25). A selecting means for selecting a printing color corresponding to the identification information detected by the originator identification information detecting means from the memory (col. 2, lines 25-28) and signal generating means (processor) for the color printer to print the color (col. 2, lines 28-31).

Inherently stated in the preceding is that the facsimile apparatus is connected through a communications network through which image data is received and sent. In addition, that a color printer is a printer that prints a plurality of colors.

Sakai fails to disclose expressly that the table contains an identification between the print colors and the communications mechanism. Sakai also fails to disclose expressly that there is a sheet media selection mechanism to select a type of sheet media.

Sakai adds that the prior art Mitsuo discloses that the printing data is printed in different colors for each communication type (col. 1, lines 41-44).

Ng adds that the header information contains an indication of the type of output medium that is to be printed (col. 6, lines 45-48) that can be used with a facsimile (col. 1, lines 14-17).

Sakai, Mitsuo & Ng are combinable because they are from the same field of endeavor and thus constitute analogous art, being that of communicating printing and facsimile devices.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a communications system which receives and transmits data to a printer that is able to associate that data with the means of communication and to select a color type based upon this and print the data on a certain media type.

The suggestion/motivation for doing so would have been that the use of color selection and media selection for printers is easily applicable to facsimile machines and is suggested as applying in the art.

Therefore, it would have been obvious to combine Sakai with Mitsuo and Ng to obtain the invention as specified in claims 1-3, 10-12 and 19-21.

Regarding **claims 4, 13 and 22**, the means of accomplishing the method or apparatus is implied within it. If a small number of potential embodiments come to them mind of one skilled in the art such that it would have been obvious to apply them as a means, such as using either G3 or G4 protocols for facsimile transmission then the reference anticipates the claim, and thus is rejected under the same justification as claim 1.

Regarding **claims 5, 14, and 23**, the means of accomplishing the method or apparatus is implied within it. If a small number of potential embodiments come to them mind of one skilled in the art such that it would have been obvious to apply them as a means, such as identification information arising from a transmitting terminal, a receiving terminal or a remote terminal, then the reference ^{is obvious over} ~~anticipates~~ the claim, and thus is rejected under the same justification as claim 3.

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Regarding claims **6, 7, 15, 16, 24 and 25**, Sakai with Mitsou have already been shown to disclose a table representing a relationship between a plurality of print colors and communication type, and selection of one of these colors, and Ng adds that sheet media selection can also be performed. The incorporation of these into a separate data table would have been obvious to one skilled in the art and thus claims 6, 7, 15, 16, 24 and 25 are rejected under the same justification as claim 1.

Regarding claim **8, 9, 17, 18, 26 and 27**, Sakai has already been shown to disclose a table representing a relationship between a plurality of print colors and identification information, and selection of one of these colors, and Ng adds that sheet media selection can also be performed. The incorporation of these into a separate data table would have been obvious to one skilled in the art and thus claims 8, 9, 17, 18, 26 and 27 are rejected under the same justification as claim 6.

Additional Notes

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hino (JP 10107936) and Ito (JP 09051388 refer to color coding for sorting; Imai ('478) and Hiratsuka ('760) refer to printing a single color; and Aikens ('494), DeSanctis ('643), Nakatani ('851), and Corona ('279) refer to sheet selection; Isemura (JP 2000299754), Miyazaki (JP 2003309702), and Yokoyama (JP 08169620) refer to sheet sorting; and Nakajima ('920) refers to transmission of color.


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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Stephany whose telephone number is 703-305-8951. The examiner can normally be reached on 8:30 am - 4:30 pm ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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